

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

115274-015

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on \_\_\_\_\_

Signature \_\_\_\_\_

Typed or printed name \_\_\_\_\_

Application Number

09-711,511

Filed

November 14, 2000

First Named Inventor

David K. Gifford

Art Unit

3623

Examiner Susana

Meinecke Diaz

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒

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Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

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November 22, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below.

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\*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant(s): David K Gifford  
Appl. No.: 09/711,511  
Conf. No.: 8013  
Filed: November 14, 2000  
Title: DIGITAL ACTIVE ADVERTISING  
Art Unit: 3623  
Examiner: Susanna M. Meinecke Diaz  
Docket No.: 115274-015

MAIL STOP - AF  
Director of Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Sir:

This request is submitted in response to the Final Office Action dated June 22, 2006, and Advisory Action dated October 4, 2006. This request is filed contemporaneously with USPTO form PTO/SB/33, "Pre-Appeal Brief Request for Review" and form PTO/SB/31, "Notice of Appeal."

**Remarks** begin on page 2 of this paper.

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### **REMARKS**

Claims 1-4 and 23 are pending in this application. Claims 1, 2, 4 and 23 are the focus of this request. Claims 1-4 and 23 stand rejected under 35 U.S.C. §103(a) as being anticipated by *Bush et al.* (U.S. Patent No. 5,475,585) in view of “ALANTEC: ALANTEC delivers another industry first; IP Multicast Routing Support for Desktop Video Conferencing and Broadcast Video” (Hereinafter “*Alantec*”). The Applicants respectfully submit the rejections are clearly improper and should be reversed by this Board.

Specifically, the cited art, alone or in combination, does not disclose at least “means for communicating a digital advertisement . . . using Internet transfer protocols” and “means for requesting, displaying and responding to digital advertising [presented using Internet transfer protocols]” as recited in claim 1 and similarly recited in claims 4 and 23. Regarding the means-plus-function claims, Applicant again submits that the Office Actions, to date, have not explained how the structure of *Bush* is the same or equivalent to the structure recited in the present Application, with or without the amendments put forth in the previous response. Additional detail regarding this argument may be found in the Response dated September 22, 2006, page 5 (starting from the 4<sup>th</sup> full paragraph).

In contrast to the present claims, *Bush* discloses a video broadcasting system that transmits video menus to a television or video screen via RF carrier signals, and further incorporates credit-card swipers and special keypads for user input (col. 3, lines 21-30; col. 5, lines 34-44, line 65 to col. 6, line 9; col. 7, lines 22-35). *Bush* teaches a high capacity data input device 202, that loads vendor-specific menus via external disk storage devices 214 and 216, where the information is transferred to the main CPU 204, which controls the overall data formatting, and transmits the formatted data to parallel data to video interface 212 (col. 4, lines 54-66). Stored advertisement are transmitted asynchronously from corresponding databases to computer dedicated processor 201, where the processor 201 performs packet formatting and output this data in a synchronous manner that is polled by the main CPU 204. The main CPU 204, performs time multiplexing to gather data belonging to various vendors and service providers, assemble the data, and transmit it over the parallel bus to video interface 212. The

video interface 212, converts the digital data into video format for transmission to receivers 26  
(col. 5, lines 10-19).

The Office Actions have failed to explain how the use of a video interface converter is a “structure” that is the same or equivalent to the structure described in the specification which corresponds to the claimed means plus function elements (MPEP 2182 - “[t]he ‘means or step plus function’ limitation should be interpreted in a manner consistent with the specification disclosure”). Applicant notes that construing means-plus-function claims is a two-step process. In the present rejection, it is apparent that the Office has applied the first step only (i.e., construing the claim “to include the limitations contained in the claim language, and only those limitations”), and has completely vitiated any subsequent analysis that is required by law (“look to the specification and identify the corresponding structure for that function”). MPEP 2182 clearly instructs that “[i]f the specification defines what is meant by the limitation for the purposes of the claimed invention, the examiner should interpret the limitation as having that meaning.”

Applicants again stress that the absence of a video interface under the teaching of *Bush* renders the entire system inoperable, and alone renders the structure materially different from the present claims. As argued previously, the use of a video interface in the present application is wholly irrelevant. Moreover, Applicant respectfully submits the assertion that “*Bush* transmits video (including related advertisements) over a packet-switched network” is not correct (see Final Office Action page 7, 4<sup>th</sup> paragraph). As previously emphasized, the video files in *Bush* are received for storage/buffering either through an asynchronous transfer from a vendor (201), or through a direct transfer from disk (202). When the video data is being prepared for transmission, the main CPU 204 polls the database and performs time multiplexing to load the data, and then forwards the transmission to the video interface that “[c]onverts the digital data into video format for transmission to receivers” (col. 5, lines 16-19).

Even if it is assumed that the loading of video data from the memory to the main CPU is “transmitting video,” it is not being done over a packet-switched network, in which packets are routed between nodes over data links shared with other traffic. Just because data is “packetized” does not mean that it is being transmitted over a packet-switched network. *Bush* explicitly

discloses that the dedicated processor 201 packetizes asynchronous transmissions and forwards them in a synchronous manner to CPU 204. However, the CPU obtains this data via time multiplexing - no packet routing or switching whatsoever is conducted in the disclosure of *Bush*. If anything, *Bush* discloses a RAID-type configuration (via SCSI/ESDI - see col. 5, lines 3-5, 20-23) for obtaining video data, which is an entirely different structure which relies on different protocols from that disclosed in the present application. Simply because *Bush* discloses “a processor, storage device and network” does not give the Patent Office license to pick and choose elements from the prior art, irrespective of their function, and ignore other elements essential to their operation (e.g., video converter, time multiplexing).

Additionally, *Bush* discloses a transmission being made by a transmitting source using a video signal that includes characters generated from a video character generator 206 (col. 1, lines 56-67; col. 3, lines 1-7; col. 5, lines 50-59; col. 6, lines 25-34). This also has not been explained in the Office Actions how the structural requirement for such a device correlates to the present claims. Also, the “means for requesting, displaying and responding to digital advertising” are supported in the specification, for example, on pages 11-13, and discloses buyer computers receiving and linking HTML forms or documents received from merchants over a packet-switched network. In contrast, *Bush* discloses a structure utilizing multiple PLL synthesized tuners (215-16), channel control demodulators (217), demodulator data separators (214) and RF switches (213) to request, display and respond to video advertisements (col. 5, line 45-col. 6, line 9; col. 7, lines 6-21). Again, the Office has ignored these elements in formulating the rejection and continues to be silent in explaining how this structure is the same or equivalent to the configuration disclosed in the present application.

Regarding claim 2, *Bush* fails to teach or suggest the features recited in the claim. The detailed arguments traversing this rejection can be found in the Response dated September 22, 2006, page 7 (starting from the bottom paragraph).

The Office Action goes further and submits that *Bush* does not “expressly teach that the digital advertisements are communicated to a buyer over the network using Internet transfer protocols.” In this regard, the Office Action relies on *Alantec* in solving these deficiencies. Applicant respectfully submits this combination is wholly improper.

There is no teaching, suggestion or motivation for one of ordinary skill in the art to combine the *Bush* and *Alantec* references in the manner suggested in the Office Action. *Alantec* discloses an IP multicast routing system where PC's networked within a LAN can submit A/V messages to a central server (PowerHub), which in turn forwards the traffic to a selected group of users "who can simultaneously participate in video conferences, and other interactive desktop applications" (paragraph 6). This clearly has no application to *Bush*, and expressly teaches away from the disclosure. *Bush* (1) does not disclose any type of LAN architecture, (2) does not disclose the use of personal computers, (3) clearly does not allow viewers to send video advertisements *to each other*, (4) expressly relies on standard video transmission for broadcast and does not contemplate IP multicasting, (5) does not rely on servers for transmitting advertisements among users over an IP network, and (6) makes no provision whatsoever for IP communication anywhere in the system. In short, the IP multicast of *Alantec* runs counter to most every feature disclosed in *Bush*. It is inconceivable that the IP multicasting of *Alantec* could be incorporated into the system of *Bush* without essentially gutting and replacing most of the essential features contained within the reference.

In light of the above, Applicants respectfully submit that the rejection to claims 1-4 and 23 is improper and should be reversed by this Panel. Applicants respectfully request that a timely Notice of Allowance be issued in this case. If any additional fees are due in connection with this application as a whole, the Office is authorized to deduct such fees from deposit account no. 02-1818. If such a deduction is made, please indicate the attorney docket no. (0115274-015) on the account statement.

Respectfully submitted,  
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Dated: November 22, 2006